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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,942	10/03/2006	Martinez-Miranda Eduardo	YSAP.PAY.PT2	8200
24943 7590 07/22/2010 INTELLECTUAL PROPERTY LAW GROUP LLP 12 SOUTH FIRST STREET SUITE 1205 SAN JOSE, CA 95113				
EXAMINER REAGAN, JAMES A				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 07/22/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pt\_docket@iplg.com

# Office Action Summary

**Application No.**

10/597,942

**Applicant(s)**

EDUARDO ET AL.

**Examiner**

JAMES A. REAGAN

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/26/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the response filed on **10/26/2009**.
2. Claims 1, 3-8, 10, 13-15, 17, 20-29, 31-36, and 38-40 have been amended.
3. Claims 41-43 have been canceled.
4. The rejections of claims 1-40 have been updated to reflect the amended limitations.
5. Claims 1-40 are currently pending and have been examined.

### **Previous Claim Objections**

6. Claims 4-16, 20-28, and 32-40 were objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiply dependent claim. See MPEP § 608.01(n). The Examiner thanks the Applicant for revising and amending the claim language and hereby withdraws the objections.

### **Previous Claim Rejections - 35 USC § 112**

7. Claims 1, 3, 17, and 31 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner thanks the Applicant for revising and amending the claim language and hereby withdraws the rejections under 35 U.S.C. 112.

**Response to Arguments**

8. Applicant's arguments received **10/26/2009** have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
  
9. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

**Claim Rejections - 35 USC § 112**

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 5, 6, 7, 11, 17, 20, 21, 22, 25, 29, 32, 33, 37, and 38 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. Claims 1, 17, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner cannot determine the metes and bounds of the claim because the claims begin with a status choice of one of used, assigned, and inactive. The claim later specifies that the status will change under a certain condition. However, under certain conditions, the status appears to remain unchanged. Clarification is required.
13. Claims 5, 6, 7, 11, 20, 21, 22, 25, 32, 33, 37, and 38 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner cannot determine the metes and bounds of the claim because the claim has been written in the alternative using an "or" statement. For the purposes of this examination, the Examiner will assume that the claim is a properly written Markush-type limitation: *...one of the group consisting of [A, B, and C].*

**Claim Rejections - 35 USC § 103**

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 3621

17. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar (US 2005/0065876 A1), hereinafter **KUMAR**, in view of Dunn et al. (US 2007/0021975 A1), hereinafter **DUNN**, and further in view of Bayne (USPGP 2005/0113073 A1), hereinafter **BAYNE**.

**Claim 1:**

**KUMAR** as shown below discloses the following limitations:

- *a payments facilitator; (see at least paragraph 0021)*
- *a plurality of accounts established by the payments facilitator, each account being operable to hold a monetary value equivalent on trust for a customer; (see at least paragraphs 0021 and 0022)*
- *where, when a payer sends a communication message to the payments facilitator to make a payment to the party, the payments facilitator allocates one of the unused accounts to the party, changes its status to assigned, and links the allocated account with a unique identifier assigned to the party, the payment thereafter being made to the allocated account; (see at least paragraph 0059)*
- *where, when the party redeems the payment such that it reaches zero, the account status is changed to inactive by the payments facilitator, and subsequently after elapse of a predetermined period of time, the account status is changed to unused by the payments facilitator (see at least paragraph 0059)*

**KUMAR** does not disclose the limitation of *each account of said plurality of accounts having a status selected from the group consisting of unused, assigned, or inactive*. However, **DUNN**, in at least paragraph 0123 discloses account status and the ability to change account status' between three choices. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the temporary account techniques of **KUMAR** with the account status technique of **DUNN** because this provides an indication of whether an account is available for use.

The combination of **KUMAR/DUNN** does not specifically disclose that an account breaches zero and its status is changed. **BAYNE**, however, in at least paragraph 0003 discloses accounts reaching a zero balance and their status being changed to inactive. **BAYNE** also discloses unbanked persons who choose to use prepaid cards in lieu of a permanent account. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the temporary account techniques of **KUMAR/DUNN** with the account status technique of **BAYNE** because this provides an indication of whether an account is available for use.

**Claim 2:**

The combination of **KUMAR/DUNN/BAYNE** discloses the limitations as shown in the rejections above. **KUMAR** further discloses *the plurality of accounts are established with at least one financial institution*. See at least paragraph 0021.

**Claim 3:**

The combination of **KUMAR/DUNN/BAYNE** discloses the limitations as shown in the rejections above. **KUMAR** further discloses *the payments facilitator being one of the group consisting of a telecommunications carrier, and a facilitator associated with a telecommunications carrier*. See at least paragraph 0010.

**Claims 4-9:**

The combination of **KUMAR/DUNN/BAYNE** discloses the limitations as shown in the rejections above. **KUMAR** further discloses *operable to assign the party's phone number as the unique identifier*. See at least paragraph 0043. In addition, **KUMAR** further discloses *identifying the unique identifier of the party from either the communication message and/or a destination address to which the communication message is sent*. See at least paragraph 0014. **KUMAR/DUNN/BAYNE** does not specifically disclose:



Art Unit: 3621

- *the unique identifier assigned to the party is selected from one of the party's mobile phone number; the party's fixed telephone number; the party's e-mail address.*
- *the unique identifier of the party is included in, or can be attained from, the communication message or the destination address to which the communication message is sent.*
- *the unique identifier of the payer is included in, or can be attained from, the communication message or the destination address to which the communication message is sent.*
- *the amount to be paid is included in, or can be attained from, the communication message or the destination address to which the communication message is sent.*
- *the payments facilitator includes a client database, the primary key of records stored in the client database being the unique identifier of the party.*
- *each record in the client database includes financial account details of the party to which the record relates.*

However, the Examiner takes **OFFICIAL NOTICE** that it is old and well known in the targeted marketing arts to utilize relational databases that contain unique identifications for each record, otherwise known as a primary key, and that the records are accumulated by accessing public records such as, for example, traditional mailings. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine/modify the method of **KUMAR/DUNN/BAYNE** with the technique of accumulating demographics because this provides a computerized method for generating profitable leads.

**Claims 10-16:**

The combination of **KUMAR/DUNN/BAYNE** discloses the limitations as shown in the rejections above. **KUMAR** further discloses PINs and passwords. See at least paragraph 0024.

**KUMAR/DUNN/BAYNE** does not specifically disclose:

- *the payments facilitator sends a first additional communication message to the payer requesting confirmation of the transfer and receives a second additional communication message from the payer confirming the transfer.*
- *the second additional communication message includes a PIN or password, the transfer proceeding if the communicated PIN or password matches a pre-stored PIN or password recorded for the payer.*
- *the payer is required to send the second additional communication message within a predetermined time period for the transfer to proceed.*
- *the payments facilitator sends a third additional communication message to the party informing them of the transfer.*
- *the payments facilitator sends a fourth additional communication message to the payer confirming the transfer has taken place.*
- *the plurality of accounts are established with at least one financial institution, and where the fourth additional communication message includes text informing the party that the money can be claimed by establishing a bank account with the at least one financial institution.*
- *when the party establishes an account with the at least one financial institution, the payments facilitator operates to transfer the money stored in the associated account to the established account.*

However, the Examiner takes **OFFICIAL NOTICE** that it is old and well known in the online electronic communication arts to send receipt and confirmation messages back and for the between involved parties. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine/modify the method of **KUMAR/DUNN/BAYNE** with the technique of

Art Unit: 3621

electronic messaging because this provides a method for confirming and communicating transactions.

**Claims 17-40:**

The combination of **KUMAR/DUNN/BAYNE** discloses the limitations as shown in the rejections above. discloses the limitations as shown in the rejections of the claims above. The Examiner finds that remaining claims 17-40 are not patentably distinct from claims 1-16 and therefore, for the sake of clarity, has grouped the rejections of claims 1-40 accordingly using the same references and citations as above.

**Conclusion**

18. Applicant's amendment received **10/26/2009** necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
20. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ANDREW J. FISCHER** can be reached at **571.272.6779**.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
22. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

Art Unit: 3621

or faxed to **571-273-8300**.

- 23.** Hand delivered responses should be brought to the **United States Patent and Trademark**

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/James A. Reagan/

Primary Examiner, Art Unit 3621